



3510-16-P

## DEPARTMENT OF COMMERCE

### United States Patent and Trademark Office

#### Proposed collection; comment request; “Rules for Patent Maintenance Fees”

**AGENCY:** United States Patent and Trademark Office, Commerce

**ACTION:** Proposed extension of an existing information collection; comment request.

**SUMMARY:** The United States Patent and Trademark Office (USPTO), as part of its continuing effort to reduce paperwork and respondent burden, invites the general public and other Federal agencies to comment on proposed and/or continuing information collections, as required by the Paperwork Reduction Act of 1995.

**DATES:** Written comments must be submitted on or before [INSERT DATE 60 DAYS AFTER THE DATE OF PUBLICATION IN THE FEDERAL REGISTER].

**ADDRESSES:** Written comments may be submitted by any of the following methods:

- *Email:* [InformationCollection@uspto.gov](mailto:InformationCollection@uspto.gov). Include “0651-0016 Rules for Patent Maintenance Fees” in the subject line of the message.

- *Mail:* Marcie Lovett, Director, Records and Information Governance Division, Office of the Chief Technology Officer, United States Patent and Trademark Office, P.O. Box 1450, Alexandria, VA 22313–1450.
- *Federal Rulemaking Portal:* <http://www.regulations.gov>.

**FOR FURTHER INFORMATION CONTACT:** Requests for additional information should be directed to Raul Tamayo, Senior Legal Advisor, Office of Patent Legal Administration, United States Patent and Trademark Office (USPTO), P.O. Box 1450, Alexandria, VA 22313– 1450; by telephone at 571–272–7728; or by email at [Raul.Tamayo@uspto.gov](mailto:Raul.Tamayo@uspto.gov) with “Paperwork” in the subject line. Additional information about this collection is also available at <http://www.reginfo.gov> under “Information Collection Review.”

## **SUPPLEMENTARY INFORMATION:**

### **I. Abstract**

Under 35 U.S.C. § 41 and 37 CFR 1.20(e)-(h) and 1.362-1.378, the United States Patent and Trademark Office (USPTO) charges fees for maintaining in force all utility patents based on applications filed on or after December 12, 1980. Payment of these maintenance fees is due at 3 1/2, 7 1/2, and 11 1/2 years after the date the patent was granted. If the USPTO does not receive payment of the appropriate maintenance fee and any applicable surcharge within a grace period of six months following each of the above due dates (at 4, 8, or 12 years after the date of grant), the patent will expire at that time. After a patent expires, it is no longer enforceable. Maintenance fees are not

required for design, plant, or reissue patents if the patent being reissued did not require maintenance fees.

Payments of maintenance fees that are submitted during the six-month grace period before patent expiration must include the appropriate surcharge as indicated by 37 CFR 1.20(h). Submissions of maintenance fee payments and surcharges must include the relevant patent number and the corresponding United States application number in order to identify the correct patent and ensure proper crediting of the fee being paid.

If the USPTO refuses to accept and record a maintenance fee payment that was submitted prior to the expiration of a patent, the patentee may petition the Director to accept and record the maintenance fee under 37 CFR 1.377. This petition must be accompanied by the fee indicated in 37 CFR 1.17(g), which may be refunded if it is determined that the refusal to accept the maintenance fee was due to an error by the USPTO.

If a patent has expired due to nonpayment of a maintenance fee, the patentee may petition the Director to accept a delayed payment of the maintenance fee under 37 CFR 1.378. The Director may accept the payment of a maintenance fee after the expiration of the patent if the petitioner shows to the satisfaction of the Director that the delay in payment was unintentional. Petitions to accept unintentionally delayed payment must also be accompanied by the required maintenance fee and the petition fee as set forth in 37 CFR 1.17(m). If the Director accepts the maintenance fee payment upon petition, then the patent is reinstated. If the USPTO denies a petition to accept delayed payment of a maintenance fee in an expired patent, the patentee may petition the Director to reconsider that decision under 37 CFR 1.378(d).

The rules of practice (37 CFR 1.33(d) and 1.363) permit applicants, patentees, assignees, or their representatives of record to specify a “fee address” for correspondence related to maintenance fees that is separate from the correspondence address associated with a patent or application. A fee address must be an address that is associated with a USPTO customer number. Customer numbers may be requested by using the Request for Customer Number Form (PTO/SB/125), which is covered under OMB control number 0651-0035. Maintaining a correct and updated address is necessary so that fee-related correspondence from the USPTO will be properly received by the applicant, patentee, assignee, or authorized representative. If a separate fee address is not specified for a patent or application, the USPTO will direct fee-related correspondence to the correspondence address of record.

The USPTO offers forms to assist the public with providing information covered by this collection, including the information necessary to submit a patent maintenance fee payment (PTO/SB/45) and to designate or change a fee address (PTO/SB/47). The USPTO offers two different versions of the petition to accept unintentionally delayed payment of maintenance fee in an expired patent under 37 CFR 1.378(b). In addition to the basic PDF that may be filled out electronically and then printed and mailed (or submitted online) (Form PTO/SB/66), the USPTO offers a Web-based ePetition, which the public can complete on a computer using a Web browser and then click a submit button to send the information to the USPTO over the Internet (ePetition). No form is associated with the petition to the Director to accept and record the maintenance fee under 37 CFR 1.377, or the petition the Director to reconsider a decision to refuse to

accept a delayed payment in an expired patent under 37 CFR 1.378(d). Both may be submitted in paper and electronic format.

Customers may submit maintenance fee payments and surcharges incurred during the six-month grace period before patent expiration by using the Maintenance Fee Transmittal Form (PTO/SB/45) or by paying online through the USPTO Web site.

However, to pay a maintenance fee after patent expiration, the maintenance fee payment and the petition fee as set forth in 37 CFR 1.17(m) must be filed together with a petition to accept unintentionally delayed payment. The USPTO accepts online maintenance fee payments by credit card, deposit account, or electronic funds transfer (EFT). Otherwise, non-electronic payments may be made by check, credit card, or deposit account.

## **II. Method of Collection**

By mail, facsimile, hand delivery, or electronically to the USPTO.

## **III. Data**

*OMB Number:* 0651–0016.

*IC Instruments:* The individual instruments in this collection, as well as their associated forms, are listed in the table below.

IC #	Form and Function	Form #
1	Maintenance Fee Transmittal Form, electronic and paper	PTO/SB/45
2	Electronic Maintenance Fee Form, electronic	No Form Associated
3	Petition to Accept Unintentionally Delayed Payment of Maintenance Fee in an Expired Patent (37 CFR 1.378(b)), electronic and paper	PTO/SB/66

4	Petition to Accept Unintentionally Delayed Payment of Maintenance Fee in an Expired Patent (37 CFR 1.378(b)) – ePetition, electronic	ePetition
5	Petition to Review Refusal to Accept Payment of Maintenance Fee Prior to Expiration of Patent (37 CFR 1.377), electronic and paper	No Form Associated
6	Petition for Reconsideration of Decision on Petition Refusing to Accept Delayed Payment of Maintenance Fee in an Expired Patent (37 CFR 1.378(d)), electronic and paper	No Form Associated
7	"Fee Address" Indication Form, electronic and paper	PTO/SB/47

*Type of Review:* Revision of a currently approved collection.

*Affected Public:* Individuals or households; businesses or other for-profits; and not-for-profit institutions.

*Estimated Number of Respondents:* 533,910 responses per year. The USPTO estimates that approximately 25% of these responses will be from small entities.

*Estimated Time per Response:* The USPTO estimates that it will take the public approximately 20 seconds (0.006 hours) to 8 hours to submit the information in this collection, including the time to gather the necessary information, prepare the appropriate form or petition, and submit the completed request to the USPTO. The time per response, estimated annual responses, and estimated annual hour burden associated with each instrument in this information collection is shown in the table below.

*Estimated Total Annual Hour Burden:* 13,878.89 hours.

*Estimated Total Annual Cost Burden (Hourly):* \$5,117,750.56. The USPTO expects that the information in this collection will be prepared by both attorneys and paralegals. The professional hourly rate for attorneys is \$438 and the professional hourly rate for paraprofessionals is \$145. These rates are established by estimates in the 2017 Report on the Economic Survey, published by the Committee on Economics of Legal Practice of the American Intellectual Property Law Association and the 2017 National Utilization and Compensation Survey published by the National Association of Legal Assistants (NALA). Therefore, the estimated total respondent cost burden for this collection will be approximately \$5,117,750.56 per year.

IC #	Item	Minutes (a)	Responses (yr) (b)	Burden (hrs/yr) (c) (a x b) / 60	Rate (\$/hr) (d)	Total Cost (\$/yr) (e) (c x d)
1	Maintenance Fee Transmittal Transactions (PTO/SB/45)	5	11,000	916.67	\$145.00	\$132,916.67
2	Electronic Maintenance Fee Transactions	0.33	425,500	2,363.89	\$145.00	\$342,763.89
3	Petition to Accept Unintentionally Delayed Payment of Maintenance Fee in an Expired Patent (37 CFR 1.378(b)) (PTO/SB/66)	60	300	300	\$438.00	\$131,400.00
4	Petition to Accept Unintentionally Delayed Payment of Maintenance Fee in an Expired Patent (37 CFR 1.378(b)) (PTO/SB/66) – ePetition	60	1,500	1,500	\$438.00	\$657,000.00
5	Petition to Review Refusal to Accept Payment of Maintenance Fee Prior to Expiration of Patent (37 CFR 1.377)	240	10	40	\$438.00	\$17,520.00

IC #	Item	Minutes (a)	Responses (yr) (b)	Burden (hrs/yr) (c) (a x b) / 60	Rate (\$/hr) (d)	Total Cost (\$/yr) (e) (c x d)
6	Petition for Reconsideration of Decision on Petition Refusing to Accept Delayed Payment of Maintenance Fee in an Expired Patent (37 CFR 1.378(d))	480	100	800	\$438.00	\$350,400.00
7	"Fee Address" Indication Form (PTO/SB/47)	5	95,500	9,137.5	\$145.00	\$3,485,750.00
	<b>Totals</b>	---	<b>533,910</b>	<b>13,878.89</b>	---	<b>\$5,117,750.56</b>

*Estimated Total Annual Cost Burden (Non-Hourly): \$1,209,457,959.50.* This information collection has annual (non-hour) cost burden in the form of filing fees and postage costs.

In this collection there are filing fees associated with the maintenance of patents, which are listed in the table below.

IC #	Item	Respondents (a)	Filing Fee (b)	Burden (a) x (b) = (c) (\$)
1	For Maintaining an Original or Any Reissue Patent, Due at 3.5 Years (large entity)	188,800	\$1,600.00	\$302,080,000.00
1	For Maintaining an Original or Any Reissue Patent, Due at 3.5 Years (small entity)	40,800	\$800.00	\$32,640,000.00
1	For Maintaining an Original or Any Reissue Patent, Due at 3.5 Years (micro entity)	2,600	\$400.00	\$1,040,000.00



1	For Maintaining an Original or Any Reissue Patent, Due at 7.5 Years (large entity)	96,000	\$3,600.00	\$345,600,000.00
1	For Maintaining an Original or Any Reissue Patent, Due at 7.5 Years (small entity)	16,200	\$1,800.00	\$29,160,000.00
1	For Maintaining an Original or Any Reissue Patent, Due at 7.5 Years (micro entity)	900	\$900.00	\$810,000.00
1	For Maintaining an Original or Any Reissue Patent, Due at 11.5 Years (large entity)	61,700	\$7,400.00	\$456,580,000.00
1	For Maintaining an Original or Any Reissue Patent, Due at 11.5 Years (small entity)	9,800	\$3,700.00	\$36,260,000.00
1	For Maintaining an Original or Any Reissue Patent, Due at 11.5 Years (micro entity)	500	\$1,850.00	\$925,000.00
1	Surcharge – 3.5 year – Late Payment Within 6 Months (large entity)	3,500	\$160.00	\$560,000.00
1	Surcharge – 3.5 year – Late Payment Within 6 Months (small entity)	6,200	\$80.00	\$496,000.00
1	Surcharge – 3.5 year – Late Payment Within 6 Months (micro entity)	700	\$40.00	\$28,000.00
1	Surcharge – 7.5 year – Late Payment Within 6 Months (large entity)	2,000	\$160.00	\$320,000.00
1	Surcharge – 7.5 year – Late Payment Within 6 Months (small entity)	2,500	\$80.00	\$200,000.00

1	Surcharge – 7.5 year – Late Payment Within 6 Months (micro entity)	300	\$40.00	\$12,000.00
1	Surcharge – 11.5 year – Late Payment Within 6 Months (large entity)	2,200	\$160.00	\$352,000.00
1	Surcharge – 11.5 year – Late Payment Within 6 Months (small entity)	1,700	\$80.00	\$136,000.00
1	Surcharge – 11.5 year – Late Payment Within 6 Months (micro entity)	200	\$40.00	\$8,000.00
3	Petition for the Delayed Payment of the Fee for Maintaining a Patent in Force (large entity)	500	\$2,000.00	\$1,000,000.00
3	Petition for the Delayed Payment of the Fee for Maintaining a Patent in Force (small entity)	1,200	\$1,000.00	\$1,200,000.00
3	Petition for the Delayed Payment of the Fee for Maintaining a Patent in Force (micro entity)	100	\$500.00	\$50,000.00
	<b>Totals</b>	<b>438,400</b>	<b>---</b>	<b>\$1,209,457,000.00</b>

The public may submit the forms and petitions in this collection to the USPTO by mail through the United States Postal Service. If the submission is sent by first-class mail, the public may also include a signed certification of the date of mailing in order to receive credit for timely filing. The USPTO estimates that the average first-class postage cost for a mailed submission will be 50 cents and that approximately 1,919 submissions per year may be mailed to the USPTO, for a total postage cost of \$959.50 per year.

IC #	Item	Responses (a)	Postage cost (b)	Total Non-hour Cost Burden (postage) (c) (a) x (b)
3	Petition to Accept Unintentionally Delayed Payment of Maintenance Fee in an Expired Patent (37 CFR 1.378(b))	6	\$0.50	\$3.00
5	Petition to Review Refusal to Accept Payment of Maintenance Fee Prior to Expiration of Patent (37 CFR 1.377)	1	\$0.50	\$0.50
6	Petition for Reconsideration of Decision on Petition Refusing to Accept Delayed Payment of Maintenance Fee in an Expired Patent (37 CFR 1.378(d))	2	\$0.50	\$1.00
7	"Fee Address" Indication Form	1,910	\$0.50	\$955.00
	<b>Totals</b>	<b>1,919</b>	<b>---</b>	<b>\$959.50</b>

The total (non-hour) respondent cost burden for this collection in the form of filing fees and postage costs is estimated to be \$1,209,457,959.50 per year.

#### IV. Request for Comments

Comments are invited on:

- (a) Whether the proposed collection of information is necessary for the proper performance of the functions of the agency, including whether the information shall have practical utility;
- (b) the accuracy of the agency's estimate of the burden (including hours and cost) of the proposed collection of information, including the validity of the methodology and assumptions used;
- (c) ways to enhance the quality, utility, and clarity of the information to be collected; and
- (d) ways to minimize the burden of the collection of information on respondents,

including through the use of automated collection techniques or other forms of information technology, e.g., permitting electronic submission of responses.

Comments submitted in response to this notice will be summarized or included in the request for OMB approval of this information collection; they will also become a matter of public record.

Marcie Lovett,

Director, Records and Information Governance Division,

Office of the Chief Technology Officer,

USPTO.

**BILLING CODE 3510-16-P**

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